

REMARKS

Claims 1-12 were pending and remain rejected. Applicants have herein cancelled claims 1-12 and added new claims 13-58. Support for the new claims can be found in the original claims and throughout the Specification, e.g., at page 9; page 12, para. 0028; page 14, para. 0031; page 15, para 0033; page 16, paras. 0035 and 0036; page 17, para. 0037; page 18, para. 0039; page 21, para. 0044; page 22, para 0045; page 23, paras. 0048 and 0049; and throughout the Examples. No new matter has been added.

In light of the amendments and the remarks herein, Applicants respectfully request reconsideration and allowance of all claims.

Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-12 under 35 U.S.C. § 103(a) as being unpatentable over Simms *et al.* (EP 0 145 550 A2) ("Simms") in view of Katta *et al.* (U.S. Pat. No. 6,093,437) ("Katta"). In particular, the Examiner stated that Simms teaches that conventional flours can be used in the preparation of cookies, that Katta teaches that barley flour is used in the preparation of cookies, and thus that it would have been obvious to include barley flour in the shelf-stable cookie dough of Simms.

Applicants respectfully disagree with respect to the pending claims. Proper analysis under § 103 requires consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition, and (2) whether the prior art would also have revealed that in so making, those of ordinary skill would have had a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Present independent claims 13 and 36 are directed to shelf-stable sweet goods dough compositions. The compositions include 0.5% barley flour by weight for claim 13, and about 0.5% to about 3.0% barley flour by weight for claim 36. At no point does Simms or Katta teach or suggest such shelf-stable sweet goods dough compositions, either alone or in combination. Simms discloses a shelf-stable cookie dough that can include flour, such as wheat flour or other flours "conventionally used" in the preparation of cookies. Simms, however, does not teach or

suggest the use of barley flour, particularly barley flour in an amount of 0.5% by weight or in an amount of about 0.5% to about 3% by weight of the dough.

Katta does not cure the deficiencies of Simms. Katta is directed to the preparation of cookies that are par-baked so that they can withstand final baking in a toaster oven, *e.g.*, a pop-up toaster oven, without dripping and burning fat on the heating elements and without falling apart; *see* Katta Col. 4, lines 47 - 63. As a first point, Applicants respectfully note that cookies with such characteristics are not “conventional” cookies, either in their dough formulations or in their functional requirements. Although not a feature of the pending claims, this “conventional” cookie issue is relevant to the motivation to combine. Thus, one having ordinary skill in the art would not have been motivated to modify the Simms’ dough compositions given the nonconventional cookie dough compositions of Katta. Applicants respectfully assert that the Examiner is thus employing improper hindsight in order to combine the two references.¹

Moreover, even ignoring the “conventional” cookie dough deficiency of Katta, that reference discloses only one cookie dough that includes barley flour: a dough having 10.07% barley flour (Sustagrain™ barley flour) by weight of the dough.² Such a solitary example, however, does not teach or suggest that one having ordinary skill in the art should modify the Simms’ shelf-stable cookie dough compositions by substituting barley flour in a total amount of 0.5% by weight or in an amount of about 0.5% to about 3% by weight of the dough, as claimed herein. There is clearly no suggestion in Katta for such amounts of barley flour. Accordingly, Applicants respectfully assert that the pending claims are not obvious, and request withdrawal of the rejections.

¹ *See McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001) (“[w]hen the art in question is relatively simple, . . . the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously”).

² *See* Katta, Col. 9. Note that 33 Baker’s % is equal to 10.07 true %.

Applicant : Harry K. Kraklow et al.
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CONCLUSION

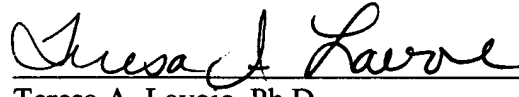
Applicants respectfully assert that all claims are in condition for allowance, which action is hereby requested. The Examiner is invited to telephone the under-signed attorney if such would expedite prosecution.

Enclosed is a \$1,045.00 check for excess claim fees and a \$225.00 check for the Petition for Extension of Time fee (2 months). Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

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